

REMARKS

Claims 1-5, 7, 9, 12-13, 18, 24-28, and 30-36 are Allowable

The Office has rejected claims 1-5, 7, 9, 12-13, 18, 24-28, 30-36, at paragraph 6 of the Office Action, under 35 U.S.C. §103(a), as being unpatentable over OmniForm User's Manual ("OmniForm"), in view of Quality Reexamination Review Sheet ("QRRS"). Applicants respectfully traverse the rejections.

None of the cited references, including OmniForm and QRRS, disclose or suggest the specific combination of claim 1. The combination of OmniForm and QRRS is missing an element of claim 1. For example, QRRS does not disclose posting an electronic form that displays criteria for infringement of a particular patent and accepts first user input to identify an infringement target and second user input to describe how the infringement target meets the criteria, as recited in claim 1. In contrast to claim 1, QRRS discloses questions pertaining to whether a reexamination proceeding is considered deficient. *See* QRRS, questions 1-8.

When the Director finds that a substantial new question of patentability affecting any claim of a patent is raised, the determination will include an order for reexamination of the patent for resolution of the question.

See 35 U.S.C. §305

Reexamination is a procedure conducted when a question of patentability exists, which is unrelated to identifying an infringement target of a valid patent. QRRS does not pertain to identifying an infringement target, but rather pertains to reexamination.

The Office Action states that the QRRS accepts user entry of a Control Number, which the Office Action states to be an infringement target identifier. However, contrary to the Office Action statement, the Control Number pertains to a reexamination procedure rather than an infringement target.

In addition, OmniForm does not disclose or suggest the elements of claim 1 not disclosed by QRRS. Instead, OmniForm discloses a way to convert paper forms to electronic forms. *See*

OmniForm, p. 1, paragraph 1. Therefore, QRRS and OmniForm, taken separately or in combination, fail to disclose each and every element of claim 1. Hence, claim 1 is allowable.

Claims 2-5, 7, 9, 12-13, 18, and 35 depend from claim 1, which Applicants have shown to be allowable. Hence, QRRS and OmniForm, taken separately or in combination, fail to disclose at least one element of each of claims 2-5, 7, 9, 12-13, 18, and 35. Accordingly, claims 2-5, 7, 9, 12-13, 18, and 35 are also allowable, at least by virtue of their dependence from claim 1.

Further, the dependent claims include additional features not disclosed by the references. For example, neither QRRS nor OmniForm disclose or suggest an electronic form including a plurality of input boxes to receive a portion of the second user input that describes how an infringement target meets a respective one of criteria for infringement of a particular patent, as recited in claim 4. In contrast to claim 4, QRRS discloses questions pertaining to whether a reexamination proceeding is considered deficient. *See* QRRS, questions 1-8. Further, OmniForm does not disclose or suggest this element of claim 4. Instead, OmniForm discloses a way to convert paper forms to electronic forms. *See* OmniForm, p. 1, paragraph 1. For this additional reason, claim 4 is allowable.

Further, neither QRRS nor OmniForm disclose or suggest evaluating the infringement submission based on the first user input and the second user input, as recited in claim 12, or that evaluating is performed by a patent attorney, as recited in claim 13. Instead, QRRS is a form including questions pertaining to whether a reexamination proceeding is considered deficient. *See* QRRS, questions 1-8. QRRS does not address evaluating an infringement submission, or involvement of a patent attorney in evaluating an infringement submission. Further, OmniForm does not disclose or suggest these elements of claims 12 and 13. Instead, OmniForm discloses a way to convert paper forms to electronic forms. *See* OmniForm, p. 1, paragraph 1. For this additional reason, claims 12 and 13 are allowable.

None of the cited references, including OmniForm and QRRS, disclose or suggest the specific combination of claim 24. For example, QRRS does not disclose a computer-readable

medium having stored thereon an electronic form to display criteria for infringement of a particular patent and to accept first user input to identify an infringement target and second user input to describe how the infringement target meets the criteria, as recited in claim 24. In contrast to claim 24, QRRS discloses questions pertaining to whether a reexamination proceeding is considered deficient. *See* QRRS, questions 1-8. Further, OmniForm does not disclose or suggest this element of claim 24. Instead, OmniForm discloses a way to convert paper forms to electronic forms. *See* OmniForm, p. 1, paragraph 1. Therefore, QRRS and OmniForm, taken separately or in combination, do not disclose or suggest each and every element of claim 24. Accordingly, claim 24 is allowable.

Claims 25-28 and 30-34 depend from claim 24, which Applicants have shown to be allowable. Hence, QRRS and OmniForm, taken separately or in combination, fail to disclose at least one element of each of claims 25-28 and 30-34. Accordingly, claims 25-28 and 30-34 are allowable, at least by virtue of their dependence from claim 24.

Further, the dependent claims include additional features not disclosed by the references. For example, neither QRRS nor OmniForm disclose or suggest an electronic form including a plurality of input boxes to receive a portion of the second user input that describes how an infringement target meets a respective one of criteria for infringement of a particular patent, as recited in claim 27. In contrast to claim 27, QRRS discloses questions pertaining to whether a reexamination proceeding is considered deficient. *See* QRRS, questions 1-8. Further, OmniForm does not disclose or suggest this element of claim 27. Instead, OmniForm discloses a way to convert paper forms to electronic forms. *See* OmniForm, p. 1, paragraph 1. For this additional reason, claim 27 is allowable.

None of the cited references, including OmniForm and QRRS, disclose or suggest the specific combination of claim 36. For example, QRRS does not disclose posting an electronic form that displays criteria for infringement of a particular patent and accepts first user input to identify infringement target information and second user input to describe how the infringement target meets the criteria, where the infringement target information does not predate the filing date of the particular patent, as recited in claim 36. In contrast to claim 36, QRRS discloses

questions pertaining to whether a reexamination proceeding is considered deficient. *See* QRRS, questions 1-8. Further, OmniForm does not disclose or suggest this element of claim 36. Instead, OmniForm discloses a way to convert paper forms to electronic forms. *See* OmniForm, p. 1, paragraph 1. Therefore, QRRS and OmniForm, taken separately or in combination, do not disclose or suggest each and every element of claim 36. Accordingly, claim 36 is allowable.

Claims 6, 19 and 29 are Allowable

The Office has rejected claims 6, 19 and 29, at paragraph 7 of the Office Action, under 35 U.S.C. §103(a), as being unpatentable over OmniForm in view of QRRS, and further in view of BountyQuest Website ("BountyQuest"). Applicants respectfully traverse the rejections.

As explained previously, OmniForm and QRRS do not disclose all of the elements of claim 1. BountyQuest does not disclose or suggest the elements of claim 1 not disclosed or suggested by OmniForm and QRRS. For example, BountyQuest does not disclose posting an electronic form that displays criteria for infringement of a particular patent and accepts first user input to identify an infringement target and second user input to describe how the infringement target meets the criteria, as recited in claim 1. In contrast to claim 1, BountyQuest is directed at invalidating a patent, rather than identifying potential infringers of a valid patent. *See* BountyQuest website, p. 9. The BountyQuest website discloses that a "hunter" wins a bounty (e.g., a cash reward) by being the first to submit a single document to invalidate a particular patent. *See* BountyQuest, pp. 13-14 ("Does a winning submission have to invalidate the patent in question?"). The "Required Elements" shown at page 16 include claim elements; however, the BountyQuest website displays "criteria for invalidity," rather than "criteria for infringement," as recited by independent claim 1. Moreover, the corresponding text input adjacent to the "criteria for invalidity" of BountyQuest receives information identifying page numbers within a prior art submission that anticipate the required element(s) of a particular claim. *See* BountyQuest, p. 16. The Office Action states that BountyQuest discloses "Lawyers whose clients have been sued or threatened with suit for patent infringement post in order to find prior art that may help them defend a case." *See* Office Action, page 20, paragraph 13. Applicant submits that a lawyer may post on BountyQuest in order to invalidate a patent for which the lawyer's client has been sued for infringement. However, BountyQuest does not serve to

identify infringers of valid patents. Therefore, OmniForm, QRRS, and BountyQuest, separately or in combination, do not disclose each and every element of claim 1, or of claims 6 and 19, which depend from claim 1. Therefore, claims 6 and 19 are allowable.

Further, the dependent claims recite additional features not disclosed by the cited references. For example, QRRS does not disclose that each claim limitation is associated with one of a plurality of display portions and one of the plurality of input boxes, as recited in claim 6. In contrast to claim 6, QRRS presents questions pertaining to deficiencies in a reexamination, and has no display portions or input boxes associated with claim limitations. *See* QRRS, questions 1-8. Further, the Office Action admits that OmniForm does not disclose this element of claim 6. BountyQuest, in contrast to claim 6, includes a form in which a "hunter" supplies information about a potentially invalidating piece of prior art, and not criteria for infringement of a particular patent, as recited in claim 6. *See* BountyQuest website, p. 16. For this additional reason, claim 6 is allowable.

Further, QRRS does not disclose sending, to the user, a message to acknowledge receipt of the infringement submission, the message indicating the date and the time associated with the infringement submission, as recited in claim 19. Instead, QRRS is a form pertaining to whether a reexamination proceeding (which pertains to invalidating a patent) is considered by an examiner to be deficient. *See* QRRS, questions 1-8. Further, the Office Action admits that OmniForm does not disclose this element of claim 19. In contrast to claim 19, BountyQuest pertains to invalidity submissions, rather than submissions pertaining to infringement of valid patents. *See* BountyQuest website, p. 9. The Office Action states that BountyQuest discloses "Lawyers whose clients have been sued or threatened with suit for patent infringement post in order to find prior art that may help them defend a case." *See* Office Action, page 20, paragraph 13. Applicants submit that a lawyer may post on BountyQuest in order to invalidate a patent for which the lawyer's client has been sued for infringement. However, BountyQuest does not serve to identify infringers of valid patents. For this additional reason, claim 19 is allowable.

As explained previously, OmniForm and QRRS do not disclose all of the elements of claim 24. BountyQuest does not disclose or suggest the elements of claim 24 not disclosed or

suggested by OmniForm and QRRS. For example, BountyQuest does not disclose a computer-readable medium having stored thereon an electronic form to display criteria for infringement of a particular patent and to accept first user input to identify an infringement target and second user input to describe how the infringement target meets the criteria, as recited in claim 24. In contrast to claim 24, BountyQuest is directed at invalidating a patent, rather than identifying potential infringers of a valid patent. *See* BountyQuest website, p. 9. Therefore, OmniForm, QRRS, and BountyQuest, taken separately or in combination, do not disclose each and every element of claim 24, or of claim 29, which depends from claim 24. Therefore, claim 29 is allowable.

Claims 10-11, 14-17, and 20 are Allowable

The Office has rejected claims 10-11, 14-17, and 20, at paragraph 8 of the Office Action, under 35 U.S.C. §103(a), as being unpatentable over OmniForm in view of QRRS, and further in view of European Patent No. EP 1 160 708 ("Utsumi"). Applicants respectfully traverse the rejections.

As explained previously, OmniForm and QRRS do not disclose or suggest each element of claim 1. Utsumi does not disclose the elements of claim 1 not disclosed by OmniForm and QRRS. For example, Utsumi does not disclose posting an electronic form that displays criteria for infringement of a particular patent and accepts first user input to identify an infringement target and second user input to describe how the infringement target meets the criteria, as recited in claim 1. In contrast to claim 1, Utsumi discloses a website to receive input to identify possible infringers, including three text inputs: an email address input window, an account number input window to provide an account number to receive payment, and a detailed information input window to receive detailed information about an infringer. Utsumi discloses only one input to receive information related to the patent number displayed on the form. *See Utsumi*, Figure 3. Utsumi fails to disclose or suggest a second user input to describe how an infringement target meets infringement criteria, as recited in claim 1. The Patent Number displayed in Fig. 3 of Utsumi (carried over from Fig. 2), does not identify an infringement target, but is merely a display of a patent number carried over from Figure 2, for which a user may provide information in Figure 3, window 23 to identify an infringement target. *See Utsumi*, paragraph 0034.

Therefore, the combination of OmniForm, QRRS, and Utsumi fails to disclose or suggest each and every element of claim 1, or of claims 10-11, 14-17, and 20, which depend from claim 1.

Further, the dependent claims include additional features not disclosed by the references. For example, neither QRRS, OmniForm nor Utsumi disclose or suggest that compensating the user is conditioned on a deal with an infringement target, as recited in claim 15, or that compensating the user comprises providing the user a fee commensurate with compensation from a deal with the infringement target, as recited in claim 17. The Office Action admits that OmniForm does not disclose these elements. In contrast to claims 15 and 17, QRRS is a form to record deficiencies in a reexamination proceeding. In further contrast to claims 15 and 17, Utsumi discloses that an amount of a reward for information provided may be determined by patent attorneys and lawyers evaluating the information for effectiveness in substantiating the infringement, or that the amount may be a fixed fee. *See* Utsumi, paragraph 0044. Thus, in Utsumi, compensation may be determined by an evaluation of the potential effectiveness in an infringement suit, rather than conditioned on a completed deal with the infringement target, or commensurate with compensation from a completed deal with the infringement target. For at least this additional reason, claims 15 and 17 are allowable.

Claims 1-5, 7, 9, 12-13, 18, 24-28, and 30-36 are Allowable

The Office has rejected claims 1-5, 7, 9, 12-13, 18, 24-28, 30-36, at paragraph 9 of the Office Action, under 35 U.S.C. §103(a), as being unpatentable over OmniForm User's Manual ("OmniForm"), in view of Quality Review Reexamination ("QRRP1"). Applicants respectfully traverse the rejections.

None of the references, including OmniForm and QRRP1, disclose or suggest the specific combination of claim 1. For example, QRRP1 does not disclose displaying criteria for infringement of a particular patent and accepts first user input to identify an infringement target and second user input to describe how the infringement target meets the criteria, as recited in claim 1. In contrast to claim 1, QRRP1 discloses a quality review form pertaining to reexamination, a procedure to invalidate a patent rather than to identify an infringement target for a valid patent, disclosing questions pertaining to whether a reexamination proceeding was conducted according to accepted practices and procedures. *See* QRRP1, questions 1-4. Further,

the Office Action admits that OmniForm does not disclose these elements of claim 1. *See* Office Action, paragraph 9. Therefore, OmniForm and QRRP1, taken separately or in combination, do not disclose or suggest each and every element of claim 1, or of claims 2-5, 7, 9, 12-13, 18, and 35, which depend from claim 1.

Further, the dependent claims include additional features not disclosed by the references. For example, neither QRRP1 nor OmniForm disclose or suggest evaluating the infringement submission based on the first user input and the second user input, as recited in claim 12, or where the evaluating is performed by a patent attorney, as recited in claim 13. The Office Action admits that OmniForm does not disclose these elements of claim 12 and claim 13. *See* Office Action, paragraph 9. In contrast to claims 12 and 13, QRRP1 discloses a quality review form for evaluating a reexamination, carried out in order to evaluate the validity of a patent, rather than evaluating an infringement submission. *See* QRRP1, questions 1-4. Further, QRRP1 does not disclose that the evaluating is performed by a patent attorney, as recited in claim 13. For this additional reason, claims 12 and 13 are allowable.

None of the references, including OmniForm and QRRP1, disclose or suggest the specific combination of claim 24. For example, QRRP1 does not disclose a computer-readable medium having stored thereon an electronic form to display criteria for infringement of a particular patent and to accept first user input to identify an infringement target and second user input to describe how the infringement target meets the criteria, as recited in claim 24. In contrast to claim 24, QRRP1 discloses questions pertaining to whether a reexamination proceeding was conducted according to accepted practices and procedures. *See* QRRP1, questions 1-4. Further, OmniForm does not disclose or suggest this element of claim 24. Instead, OmniForm discloses a way to convert paper forms to electronic forms. *See* OmniForm, p. 1, paragraph 1. Therefore, QRRP1 and OmniForm, taken separately or in combination, do not disclose or suggest each and every element of claim 24. Accordingly, claim 24 is allowable.

Claims 25-28 and 30-34 depend from claim 24, which Applicants have shown to be allowable. Hence, QRRS and OmniForm, taken separately or in combination, fail to disclose at

least one element of each of claims 25-28 and 30-34. Accordingly, claims 25-28 and 30-34 are allowable, at least by virtue of their dependence from claim 24.

Further, the dependent claims include additional features not disclosed by the references. For example, neither QRRP1 nor OmniForm disclose or suggest an electronic form including a plurality of input boxes to receive a portion of the second user input that describes how an infringement target meets a respective one of criteria for infringement of a particular patent, as recited in claim 27. In contrast to claim 27, QRRP1 discloses questions pertaining to whether a reexamination proceeding has been conducted according to accepted practices and procedures. *See* QRRP1, questions 1-4. Further, OmniForm does not disclose or suggest this element of claim 27. Instead, OmniForm discloses a way to convert paper forms to electronic forms. *See* OmniForm, p. 1, paragraph 1. For this additional reason, claim 27 is allowable.

None of the cited references, including OmniForm and QRRP1, disclose or suggest the specific combination of claim 36. For example, QRRP1 does not disclose posting an electronic form that displays criteria for infringement of a particular patent and accepts first user input to identify infringement target information and second user input to describe how the infringement target meets the criteria, where the infringement target information does not predate the filing date of the particular patent, as recited in claim 36. In contrast to claim 36, QRRP1 discloses questions pertaining to whether a reexamination proceeding was conducted according to accepted practices and procedures. *See* QRRP1, questions 1-4. Further, OmniForm does not disclose or suggest this element of claim 36. Instead, OmniForm discloses a way to convert paper forms to electronic forms. *See* OmniForm, p. 1, paragraph 1. Therefore, QRRP1 and OmniForm, taken separately or in combination, do not disclose or suggest each and every element of claim 36. Accordingly, claim 36 is allowable.

Claims 6, 19 and 29 are Allowable

The Office has rejected claims 6, 19 and 29, at paragraph 10 of the Office Action, under 35 U.S.C. §103(a), as being unpatentable over OmniForm in view of QRRP1, and further in view of BountyQuest Website ("BountyQuest"). Applicants respectfully traverse the rejections.

As explained previously, OmniForm and QRRP1 do not disclose all of the elements of claim 1. BountyQuest does not disclose or suggest the elements of claim 1 not disclosed or suggested by OmniForm and QRRP1. For example, BountyQuest does not disclose posting an electronic form that displays criteria for infringement of a particular patent and accepts first user input to identify an infringement target and second user input to describe how the infringement target meets the criteria, as recited in claim 1. In contrast to claim 1, BountyQuest is directed at invalidating a patent, rather than identifying potential infringers of a valid patent. See BountyQuest, p. 9. Therefore, OmniForm, QRRP1, and BountyQuest, taken separately or in combination, fail to disclose each and every element of claim 1, or of claims 6 and 19, which depend from claim 1. Therefore, claims 6 and 19 are allowable.

As explained previously, OmniForm and QRRP1 do not disclose all of the elements of claim 24. BountyQuest does not disclose or suggest the elements of claim 1 not disclosed or suggested by OmniForm and QRRP1. For example, BountyQuest does not disclose a computer-readable medium having stored thereon an electronic form to display criteria for infringement of a particular patent and to accept first user input to identify an infringement target and second user input to describe how the infringement target meets the criteria, as recited in claim 24. In contrast to claim 24, BountyQuest is directed at invalidating a patent, rather than identifying potential infringers of a valid patent. See BountyQuest, p. 9. Therefore, OmniForm, QRRP1, and BountyQuest, taken separately or in combination, fail to disclose each and every element of claim 24, or of claim 29, which depends from claim 24. Therefore, claim 29 is allowable.

Claims 10-11, 14-17, and 20 are Allowable

The Office has rejected claims 10-11, 14-17, and 20, at paragraph 11 of the Office Action, under 35 U.S.C. §103(a), as being unpatentable over OmniForm in view of QRRP1, and further in view of Utsumi. Applicants respectfully traverse the rejections.

As explained previously, the combination of OmniForm and QRRP1, does not disclose or suggest all of the elements of claim 1. Utsumi does not disclose the elements of claim 1 not disclosed by OmniForm and QRRP1. For example, as explained above with reference to claims 10-11, 14-17, and 20, Utsumi does not disclose posting an electronic form that displays criteria

for infringement of a particular patent and accepts first user input to identify an infringement target and second user input to describe how the infringement target meets the criteria, as recited in claim 1. In contrast to claim 1, Utsumi discloses only one input window to receive information related to the patent number displayed on the form. *See Utsumi*, Figure 3. Utsumi fails to disclose or suggest a second user input to describe how an infringement target meets infringement criteria, as recited in claim 1. The Patent Number displayed in Fig. 3 of Utsumi (carried over from Fig. 2), does not identify an infringement target, but is merely a display of a patent number carried over from Figure 2, for which a user may provide information in Figure 3, window 23 to identify an infringement target. *See Utsumi*, paragraph 0034. Therefore, the combination of OmniForm, QRRP1, and Utsumi fails to disclose or suggest each and every element of claim 1, or of claims 10-11, 14-17, and 20, which depend from claim 1. Therefore, claims 10-11, 14-17, and 20 are allowable.

Further, the dependent claims recite additional elements not disclosed by the references. For example, Utsumi does not disclose or suggest that compensating the user is conditioned on a deal with an infringement target, as recited in claim 15, or that compensating the user comprises providing the user a fee commensurate with compensation from a deal with the infringement target, as recited in claim 17. In contrast to claims 15 and 17, Utsumi discloses an amount of the reward for information provided may be determined by patent attorneys and lawyers evaluating the information for effectiveness in substantiating the infringement, or that the amount may be a fixed fee. *See Utsumi*, paragraph 0044. Further, the Office Action admits that OmniForm does not disclose these elements of claims 15 and 17. Additionally, QRRP1 fails to disclose or suggest these elements of claims 15 and 17. Instead, QRRP1 discloses questions pertaining to whether a reexamination proceeding was conducted according to accepted practice and procedures. *See QRRP1*, questions 1-4. For at least this additional reason, claims 15 and 17 are allowable.

Claims 1-7, 9-22, and 24-36 are Allowable

The Office has rejected claims 1-7, 9-22, and 24-36, at paragraph 12 of the Office Action, under 35 U.S.C. §103(a), as being unpatentable over Utsumi in view of BountyQuest. Applicants respectfully traverse the rejections.

None of the references, including Utsumi and BountyQuest, disclose or suggest the specific combination of claim 1. For example, as explained previously regarding claims 10-11, 14-17, and 20, Utsumi does not disclose posting an electronic form that displays criteria for infringement of a particular patent and accepts first user input to identify an infringement target and second user input to describe how the infringement target meets the criteria, as recited in claim 1. In contrast to claim 1, Utsumi discloses only one input (window 23 of Figure 3) to receive information related to the patent number displayed on the form. *See Utsumi*, Figure 3. Utsumi fails to disclose or suggest a second user input to describe how an infringement target meets infringement criteria, as recited in claim 1. The Patent Number displayed in Fig. 3 of Utsumi (carried over from Fig. 2), does not identify an infringement target, but is merely a display of a patent number carried over from Figure 2, for which a user may provide information in Figure 3, window 23 to identify an infringement target. *See Utsumi*, paragraph 0034. Further, BountyQuest does not disclose or suggest this element of claim 1. In contrast to claim 1, BountyQuest is directed at invalidating a patent, rather than identifying potential infringers of a valid patent, and discloses an electronic form that indicates patent invalidation criteria. *See* BountyQuest website, p. 9, p. 16. Therefore, Utsumi and BountyQuest, taken separately or in combination, fail to disclose or suggest each and every element of claim 1, or of claims 2-7, 9-22, and 35 which depend from claim 1. Accordingly, claims 2-7, 9-22 and 35 are allowable over the combination of Utsumi and BountyQuest.

None of the references, including Utsumi and BountyQuest, disclose or suggest the specific combination of claim 24. For example, Utsumi does not disclose a computer-readable medium having stored thereon an electronic form to display criteria for infringement of a particular patent and to accept first user input to identify an infringement target and second user input to describe how the infringement target meets the criteria, as recited in claim 24. In contrast to claim 24, as explained previously with reference to claims 10-11, 14-17, and 20, Utsumi discloses only one input to receive information related to the patent number displayed on the form. *See Utsumi*, Figure 3. Utsumi fails to disclose or suggest a second user input to describe how an infringement target meets infringement criteria, as recited in claim 1. The Patent Number displayed in Fig. 3 of Utsumi (carried over from Fig. 2), does not identify an

infringement target, but is merely a display of a patent number carried over from Figure 2, for which a user may provide information in Figure 3, window 23 to identify an infringement target. See *Utsumi*, paragraph 0034. Further, BountyQuest does not disclose this element of claim 24. In contrast to claim 24, BountyQuest is directed at invalidating a patent, rather than identifying potential infringers of a valid patent, and discloses an electronic form that indicates patent invalidation criteria. See BountyQuest website, p. 9, p. 16. Therefore, *Utsumi* and BountyQuest, taken separately or in combination, fail to disclose or suggest each and every element of claim 24, or of claims 25-34, which depend from claim 24. Therefore, claims 24-34 are allowable.

None of the references, including *Utsumi* and BountyQuest, disclose or suggest the specific combination of claim 36. For example, *Utsumi* does not disclose posting an electronic form that displays criteria for infringement of a particular patent and accepts first user input to identify infringement target information and second user input to describe how the infringement target meets the criteria, where the infringement target information does not predate the filing date of the particular patent, as recited in claim 36. In contrast to claim 36, *Utsumi* discloses only one input (window 23) to receive information related to the patent number displayed on the form. See *Utsumi*, Figure 3. *Utsumi* fails to disclose or suggest a second user input to describe how an infringement target meets infringement criteria, as recited in claim 36. Further, BountyQuest does not disclose this element of claim 36. In contrast to claim 36, BountyQuest is directed at invalidating a patent, rather than identifying potential infringers of a valid patent, and discloses an electronic form that indicates patent invalidation criteria. See BountyQuest, p. 9, p. 16. Therefore, *Utsumi* and BountyQuest, taken separately or in combination, fail to disclose or suggest each and every element of claim 36. Accordingly, claim 36 is allowable.

Further, the asserted combination of *Utsumi* and the BountyQuest website fails to disclose or suggest a motivation to modify *Utsumi* to include the teachings of the BountyQuest website.

Determination of obviousness can not be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention. There must be a teaching or suggestion within the prior art, or within the general knowledge of a person of ordinary skill in the field of the invention, to look to particular sources of information, to select particular elements, and to combine them in the way they were combined by the inventor.

ATD Corp. v. Lydall, Inc., 159 F.3d 534, 48 USPQ2d 1321 (Fed. Cir. 1998).

Utsumi discloses a system to solicit information from third parties to identify potential infringers of intellectual property rights and to reimburse a third party for contributing such information. *See* Utsumi, Abstract. The BountyQuest website discloses a system to solicit information from third parties to invalidate patents and to reimburse a third party for being the first to contribute such prior art information. *See* BountyQuest, p. 3. It would not have been obvious to modify the infringer identification system of Utsumi to include the teachings of the prior art solicitation system of the BountyQuest website, because they solve different problems (identifying infringers of a patent versus identifying prior art to invalidate a patent). The combination represents impermissible hindsight reconstruction, and should be withdrawn.

Moreover, the infringer identification system of Utsumi teaches away from the prior art solicitation system of the BountyQuest website. The infringer identification system of Utsumi is directed to enforcement of intellectual property rights, while the prior art solicitation system of the BountyQuest website is directed to preventing enforcement of intellectual property rights. Soliciting invalidating prior art information, as taught by the BountyQuest website, frustrates the purpose of the infringer identification system of Utsumi, namely to identify patent infringers, as taught by Utsumi.

If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.

See In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

Modifying the patent infringer identification system of Utsumi to include the invalidating prior art solicitation system of the BountyQuest website would render the infringer identification system of Utsumi unsatisfactory for its intended purpose, since the identification of invalidating prior art (as taught by the BountyQuest website) would undermine the enforcement effort associated with infringer identification (Utsumi).

Accordingly, for the reasons presented above, the combination of Utsumi and BountyQuest is improper and should be withdrawn.

**RECEIVED
CENTRAL FAX CENTER****MAY 21 2007****CONCLUSION**

Applicants have pointed out specific features of the claims not disclosed, suggested, or rendered obvious by the references applied in the Office Action. Accordingly, Applicants respectfully request reconsideration and withdrawal of each of the objections and rejections, as well as an indication of the allowability of each of the pending claims.

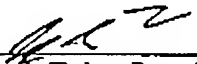
Any changes to the claims in this amendment, which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

The Examiner is invited to contact the undersigned attorney at the telephone number listed below if such a call would in any way facilitate allowance of this application.

The Commissioner is hereby authorized to charge any fees, which may be required, or credit any overpayment, to Deposit Account Number 50-2469.

Respectfully submitted,

5-21-2007
Date


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